

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/511,896 Confirmation No. : 6423
First Named Inventor : Hideki MIYANISHI
Filed : June 20, 2005
TC/A.U. : 3651
Examiner : K. Singh

Docket No. : 037297.55537US
Customer No. : 23911

Title : Flexible Transfer Installation and Foodstuff Transfer System Provided with the Flexible Transfer Installation

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests that the finality of the Office Action mailed March 28, 2007 be withdrawn pursuant to the provisions of M.P.E.P. §706.07(a), (c) and (d).

In the Office Action of September 26, 2006, claims 13-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fenty, US 5,277,301 in view of Killen, US 3,783,777. Applicant's Reply filed January 25, 2007 amended claim 13 only to make minor grammatical corrections and to incorporate limitations previously recited in claim 14. These amendments did not raise any new issues requiring further consideration or search because the features added to claim 13 were all previously presented in claim 14 and must necessarily have been searched and considered during the examination of original claims 13-19.

The Office Action mailed March 28, 2007 raised a new grounds of rejection by additionally citing Lago, US 5,228,557 and rejecting claims 13-19 under 35 U.S.C. § 103(a) over the combination of Fenty, Lago and Killen. However, notwithstanding this new ground of rejection, the Office Action was nevertheless made final.

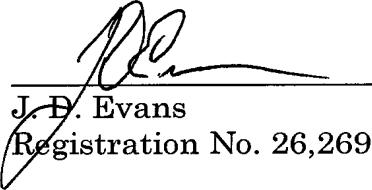
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It is, of course, permissible to make a second Office Action containing a new ground of rejection final if the new ground of rejection was necessitated by Applicant's claim amendment. However, if Applicant's amendment does not necessitate a new search, then making the next Office Action Final is not permitted. Significantly, the Office Action of March 28, 2007 does not state that the additional citation of Lago and new grounds of rejection were necessitated by Applicant's amendments. Indeed, the Office Action could not have properly made such a statement because the features of amended claim 13 had all previously been in issue.

It follows that the finality of the Office Action was premature because the Office Action cited a new reference and raised a new ground of rejection not necessitated by Applicant's amendments. Applicant therefore respectfully requests that the finality of the Office Action mailed March 28, 2007 be withdrawn pursuant to the provisions of M.P.E.P. § 706.07 (a), (c) & (d).

Respectfully submitted,

July 30, 2007


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